

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROCHUS JONAS, MICHAEL WOLF,
and NORBERT BEIER

Appeal No. 1999-1681
Application 08/634,830

HEARD:
October 9, 2001

Before WINTERS, WILLIAM F. SMITH, and ADAMS, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

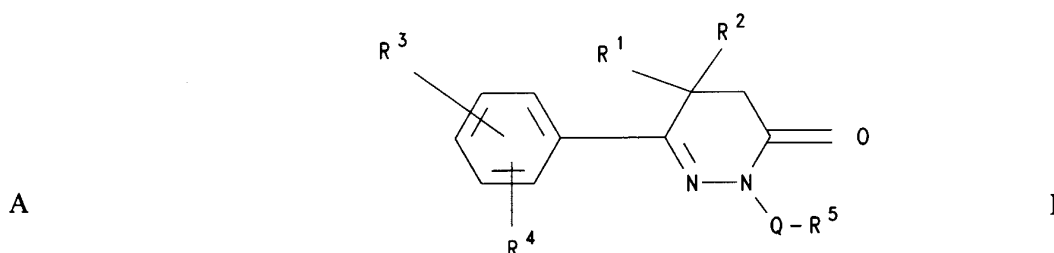
This appeal was taken from the examiner's decision rejecting claims 1, 2, 5, 6, and 12 through 16. Claim 3 stands objected to as depending from a rejected base claim, but would be allowable if rewritten in independent form (Examiner's Answer, page 2). Claims 7 through 11, which are the only other claims remaining in the application, stand withdrawn from further consideration by the examiner as directed to a non-elected invention.

REPRESENTATIVE CLAIMS

Claims 1, 5, and 6, which are illustrative of the subject matter on appeal, read as follows:

R^8 and R^9 in each case independently of one another are H, -COOA, -SO-A, -SO₂A, -

CONH₂, -CONHA,
1. A compound of the formula I



in which

R^1 and R^2 in each case independently of one another are H or A,

R^3 and R^4 in each case independently of one another are

-OH, -OR¹⁰, -S-R¹⁰, -SOR¹⁰, -SO₂R¹⁰, Hal,

-NO₂, -NH₂, -NHR¹⁰ or -NR¹⁰R¹¹,

R^5 is a phenyl radical which is mono- or disubstituted by R^6 and/or R^7 ,

Q is absent or is alkylene having 1-6 C atoms,

R^6 and R^7 in each case independently of one another are -NH₂, -NR⁸R⁹, -NHR¹⁰, -

NR¹⁰R¹¹, -NO₂, Hal, -CN, -COOH or -COOA,

R^{10} and R^{11} both are A, cycloalkyl having 3-7 C atoms, methylenecycloalkyl having 4-8 C

5. A process for the production of a pharmaceutical composition, comprising

6. A pharmaceutical composition comprising at least one compound of the formula I according to claim 1 and/or one of its physiologically acceptable salts and at least one solid, id

THE REFERENCES

The prior art references relied on by the examiner are:

Yamamoto et al. (Yamamoto)	3,682,914	Aug 8, 1972
Hakim et al. (Hakim)	3,975,388	Aug 17, 1976
Sircar (Sicar '854)	4,397,854	Aug 9, 1983
Sicar et al. (Sicar et al. '415)	4,734,415	Mar 29, 1988

Burger, Alfred (editor), Medicinal Chemistry, Second Edition, Interscience Publishers, Inc., New York, page 43 (1960)

THE REJECTIONS

The appealed claims stand rejected as follows:

- (1) Claims 1, 2, 5, 6, and 12 through 16 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Sicar '854 and Burger;
- (2) Claims 1, 2, 5, 6, and 12 through 16 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Hakim, Sicar '854, Sicar et al '415, and Burger;
- (3) Claims 1, 2, 5, 6 and 12 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Yamamoto and Burger;
- (4) Claim 5 under 35 U.S.C. § 103 as "the obvious method of making a mixture and therefore unpatentable" (Examiner's Answer, page 12); and

Appeal No. 1999-1681
Application 08/634,830

(5) Claims 1, 2, 5, 6, and 12 through 16 under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure.

DISPOSITION

On consideration of the record, we find that the examiner's rejections have little merit. For the reasons succinctly stated in applicants' Appeal Brief and Reply Brief, we shall not sustain any of the prior art or non-prior art rejections. The examiner's decision, rejecting claims 1, 2, 5, 6, and 12 through 16, is reversed.

REVERSED

Sherman D. Winters
Administrative Patent Judge

William F. Smith
Administrative Patent Judge

Donald E. Adams
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS AND
)
) INTERFERENCES
)
)
)
)

Millen, White, Zelano, and Branigan
Arlington Courthouse Plaza I Suite 1400

Appeal No. 1999-1681
Application 08/634,830

2200 Clarendon Boulevard
Arlington, VA 22201

Eld